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On

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,646	07/09/2001	Klaus Ulrich	VI/98-023.DE	7684

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04/15/2003

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EXAMINER

SERKE, CATHERINE

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 04/15/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/763,646

Applicant(s)

URICH, KLAUS

Examiner

Catherine Serke

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3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) <sup>11-25, 21-33</sup> ~~47-53~~ 49-55, 59, 60, 62-70, 72-84, 86-99, 101-107, 109-137, 139, 140, 142 and 143 is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 13-15, 34-41, 45-47, 138 and 141 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 16, 28-30, 43, 44 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,4-9,11-25,27-34,37-41,43-55,59,60,62-70,72-84,86-99,101-107 and 109-143.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 13-15, 34-41, 45-47, 138 and 141 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenwald (US '670).

Rosenwald discloses a body (2) comprising a distal discharge end (15), a plunger (13), and at least one agitation element (14) disposed within the body between the plunger and the distal discharge end. The device also has a recess (13b,12) in the plunger and the body of the syringe. The agitation element may be constructed from steel (density greater than fluid) or be a gas since all fluids contain dissolved gas. Regarding the functional language in the claims, as long as the prior art meets the structural limitations of the claims and is capable of performing the recited function then the prior art reads on the claims. Specifically, the syringe of Rosenwald is capable of being used with an injector system. The particulars of the injector system is irrelevant since the injector system itself is not positively claimed.

### *Allowable Subject Matter*

~~17-33~~ **17-25, 27-33**

Claims ~~17-33~~, 49-55, 59-60, 62-70, 72-84, 86-99, 101-107, 109-137, 139-140 and 142-143 are allowed.

Claims 11-12, 16, 43-44, 28-30 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

In response to applicant's arguments, the recitation "for use with an injector system comprising a movement mechanism and a control device operably associated with the movement mechanism" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Additionally, applicant asserts that independent claims 1 and 34 require (1) an ultrasound contrast agent and (2) a control device operable to control the movement / rotation of the syringe induced by the movement mechanism to substantially maintain the homogeneity and integrity of the ultrasound contrast fluid without substantially impairing the diagnostic properties thereof. This assertion is incorrect since these limitations are not positive limitations of the claims.

An ultrasound contrast fluid is not a positive limitation of the claims. Rather, the way the claim is constructed the agitation element has to be operable (a functional term) to agitate an ultrasound contrast fluid. The invention does not depend on the ultrasound contrast fluid but on

the fact that the agitation element has to be operable to do this function which the prior art is capable of doing.

Claims 1 and 34 are drawn to "A syringe **for use with...**". The invention of these claims is the syringe and not the combination of a syringe with an injection system. This is further shown by the fact that the preamble ends with "the **syringe** comprising:". Therefore, the positively recited limitations in the body of the claim further define the syringe alone. The fact that the body of the claim further describes the control system that the syringe may be used with is irrelevant. These are not further limitations on the invention being claimed.

Based on applicant's comments, the examiner is under the impression that applicant wishes the description of the control system to be given patentable weight. The examiner suggests that applicant amend the preamble of these claims to be drawn to an injector system or a syringe in combination with an injector system and positively recite all the limitations of that injector system in the body of the claim.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.

Catherine Serke   
April 7, 2003

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER STP